

REMARKS

I. Pending Claims

Following entry of the amendment, claims 30, 32-39, 42-50, 52-59, and 61-68 will be pending. In the Final Office Action, the Office indicated that claim 51 was objected to, but would be allowable if rewritten in independent form. Final Office Action, page 4. Applicants have accordingly added new claim 68, which is claim 51 rewritten in independent form, and canceled claim 51. Support for new claim 68 is found directly in claim 30 and claim 51. This amendment therefore adds no new matter.

Claims 30, 32-39, 42-50, 52-58 and new claim 68 are directed to aerosol compositions comprising at least one particular grafted silicone and at least one aqueous dispersion of insoluble particles of at least one cationic polymer. Claims 59 and 61-64 are directed to various forms of this composition. Claim 65-67 are directed to a non-therapeutic process for fixing a keratin substance using the claimed composition.

II. Rejection Under 35 U.S.C. § 103(a)

The Office has maintained the rejection of claims 30, 32-39, 42-50, 52-59 and 61-67 as unpatentable over WO 93/23009 to Kumar et al. ("*Kumar*"). Advisory Action mailed February 8, 2005. The Office continues to assert that *Kumar* alone would have provided sufficient motivation to make the alleged modifications to arrive at the presently claimed invention. Applicants continue to disagree for the reasons of record.

The Office continues to allege, as of record, that *Kumar* teaches cosmetic compositions, such as aerosol sprays and pump sprays, comprising the claimed at least one grafted silicone. See *Final Office Action*, pages 2-3. *Kumar* is said to teach that its

grafted silicone can be used with conventional polymers such as anionic, cationic, or amphoteric polymers and solvents to disperse the silicone. *Id.* at 3. The Office admits, however, that *Kumar* fails to teach “aqueous dispersion of insoluble particles of at least one cationic polymer.” *Id.* Despite this failing, the Office in the Final Office Action summarily concluded that it would have been obvious to combine any conventional polymer, including cationic polymers, with the grafted silicone in *Kumar*, and “depending on the polymer used, choose a solvent such that a dispersion or a solution containing silicone polymer is prepared. . . .” *Id.* at 3.

Applicants disagree and maintain their position that *Kumar* provides no motivation to modify its silicone polymer compositions. Applicants again note that *Kumar* does not teach or suggest the selection of a cationic polymer from among those mentioned, let alone the use of an aqueous dispersion of insoluble particles of the at least one cationic polymer. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). The Office’s position disregards this guidance in the M.P.E.P. that the fact that the claimed elements were known in the art is not sufficient to establish a prima facie case of obviousness *unless some objective reason is also provided to combine the elements. Id.* (emphasis added).

Here the Office has not provided any reasons why the ordinary artisan would have selected a cationic polymer from among the types of polymers noted by *Kumar* on page 42, lines 21-26, as polymers which *could*, but do not *need*, be used in hair care products with the silicone polymer. *Kumar* describes the anionic, nonionic, cationic, and

amphoteric polymers as *optional* ingredients. Indeed, *Kumar* states that “the copolymers in accordance with the present invention are used in these hair care products as a *partial or total substitute for* or in combination with anionic, nonionic, cationic, and amphoteric polymers, and polysiloxane polymers conventionally used in these hair care products.” *Kumar*, page 42, lines 21-26 (emphasis added).

In the Advisory Action mailed February 8, 2005, the Office argues this passage suggests the combination. Applicants again respectfully submit that *Kumar* does not teach that *the combination is desirable*, only that it is possible. *Kumar* provides no indication that it would be desirable to combine at least one grafted silicone polymer having a polysiloxane skeleton grafted with non-silicone organic monomers and at least one aqueous dispersion of insoluble particles of at least one cationic polymer. Notably, *Kumar* does not differentiate among anionic, nonionic, cationic, and amphoteric polymers. *Kumar*, therefore, cannot provide the requisite motivation to combine because *Kumar* does not provide any reason to select a cationic polymer from among the polymers mentioned as optional ingredients. Further, the teaching by *Kumar* that its composition was, in and of itself, sufficient to fix a keratin substance demonstrates that *Kumar* could not possibly have motivated the ordinary artisan at the time the invention was made to try to formulate new compositions, using additional ingredients such as the polymers, that would provide improved fixing power. *Kumar* cannot be relied upon to provide motivation to correct a problem that *Kumar* teaches *was already solved*. Accordingly, the Office has not established a prima facie case of obviousness for at least these reasons.

The Office also argues that “choosing an appropriate polymer from a group of polymers, all of which are taught for the same effect, by optimization would have been within the scope of a skilled artisan.” *Final Office Action* page 6. This argument is repeated in the Advisory Action, but the Office still does not point to any teaching in *Kumar* that the addition of any second polymer to the composition is a result-effective variable with respect to the ability of the composition to fix a keratin substance. In contrast to *Kumar*, the present specification discloses that compositions containing aqueous dispersions of insoluble polymer particles may not sufficiently fix the hair or provide satisfactory cosmetic properties. *Specification*, page 1, lines 14-20. *Kumar* is completely silent as to whether aqueous dispersions of insoluble particles of cationic polymer would improve hair properties when combined with at least one grafted silicone polymer. Thus, at the time of the present invention, one skilled in the art would not have found any suggestion in *Kumar* to formulate compositions comprising the presently claimed grafted silicone and at least one aqueous dispersion of insoluble particles of at least one cationic polymer.

In the Advisory Action, the Office asserted that Applicants had “failed to show the added advantage of including cationic polymers to the silicone polymers.” Advisory Action. Applicants respectfully point out that the specification does disclose the advantage of including at least one aqueous dispersion of insoluble particles of at least one cationic polymer in a composition comprising at least one grafted silicone polymer having a polysiloxane skeleton grafted with non-silicone organic monomers. In particular, the specification discloses that this combination overcomes the drawbacks of the prior art compositions. *Specification*, page 2, lines 10-15. The next sentence in the

specification emphasizes that compositions employing the combination of the claims “have good fixing power.” *Specification*, page 2, lines 16-19. Taken in the context of the discussion on pages 1-2 of the specification regarding the insufficiencies of the prior art compositions, it is clear that Applicants appreciated that the claimed combination provided superior fixing power. See *Specification*, pages 1-2.

Finally, as noted above, the Office acknowledges that *Kumar* fails to teach “aqueous dispersion of insoluble particles of at least one cationic polymer.” *Final Office Action*, page 3. The Office previously pointed to *Kumar*’s teaching on page 43, lines 6-10, that, in preparing the compositions containing the silicon polymer, a solvent must be selected to either disperse or dissolve the silicon polymer. *Id.* at page 6. The Office again relies on this general teaching of dispersing solvents in the Advisory Action. But, as previously noted, the section of *Kumar* relied upon by the Office refers to the silicone polymer and says nothing about how the cationic polymer should be formulated. In the Advisory Action, the Office once again fails to address *how* the teachings of *Kumar* render obvious this element of the claims. “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. § 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). The Office has thus also failed to establish a *prima facie* case of obviousness because it has not shown how the claimed “aqueous dispersion of insoluble particles of at least one cationic polymer” is taught or suggested by *Kumar*.

Conclusion

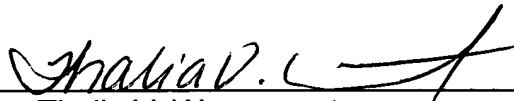
In view of the foregoing remarks, Applicants submit that this claimed invention is not rendered obvious in view of the prior art reference cited against this application. Applicants therefore request the Office's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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